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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,219	10/15/2003	Calvin Wang	021756-002700US	8072
51206 7590 10/27/2008 TOWNSEND AND TOWNSEND AND CREW LLP TWO EMBARCADERO CENTER 8TH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER				
STRANGE, AARON N				
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2453				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/687,219

Applicant(s)

WANG ET AL.

Examiner

AARON STRANGE

Art Unit

2453

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The Examiner would like to note that the present application has been reassigned to a new Examiner.

Response to Arguments

2. Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 15-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
5. Claim 15 recited a "device" comprising several components "configured to" perform various actions. The specification of the present application states that the "present invention may be implemented ... only in software" (§50). When read in light of the specification, one of ordinary skill in the art would have understood the claimed functional elements to include software per se, and not be limited to hardware "devices". Since the claims not limited to statutory subject matter, it is non-statutory.

6. Claim 21 is directed to a system comprising a device similar to the one claimed in claim 15. Since claim 21 fails to add any additional elements limiting the claim to hardware, it is non-statutory for the reasons discussed above with respect to claim 15.

7. All claims not individually rejected are rejected by virtue of their dependency from the above claims and their failure to correct the above noted deficiencies.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-3, 7, 8, 11, 12, 15-17 and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda (US 2003/0229670) in view of Kilduff (US 2003/0236763).

10. With regard to claim 1, Beyda discloses a method for messaging with devices in order to determine one or more actions to perform, the method comprising:

storing information associating the one or more actions with a message (acceptable responses are associated with a message to be sent to a user) (¶77-78), the stored information comprising action information corresponding to the one or more

actions that enables applications to perform the one or more actions (the application may perform actions in response to the user's decision, such as transferring bank funds)(¶77-78);

sending a message to a device, the message including one or more action identifiers corresponding to the one or more actions (message containing the allowable responses, such as yes/no, is sent to the user)(¶77-78);

receiving a response message from the device (user responds to the message with their choice)(¶77);

determining an action identifier in the one or more action identifiers from the received message (message is parsed to determine whether the message contains an allowable response)(¶77-78);

determining action information in the stored information corresponding to an action in the one or more actions using the action identifier (determine what action, if any, corresponds to the response)(¶77-78); and

performing the action using the action information (application performs the associated action in accordance with the user's response, such as transferring funds as requested)(¶77-78).

Beyda fails to specifically disclose that the message sent to the device includes a message identifier used to retrieve the stored information associating the actions and the message, even though some sort of identification is almost certainly included the message since the response message contains only a "1" or "2" and does not contain

the original alert message (§77). Some mechanism must be used to determine which actions are associated with the "1" or "2".

Ahmed discloses a similar system for sending and receiving electronic messages (Abstract). Ahmed teaches utilizing a message identifier associated with an original message to identify a reply to the original message (col. 9, l. 62 to col. 10, l. 20). This would have been an advantageous addition to the system disclosed by Beyda, since it allows reply messages to be associated with original messages without requiring the reply messages to duplicate the content of the original message (Ahmed; col. 10, ll. 16-20).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include an identifier in the message sent to the device and to include the identifier in any response message to allow the middleware to determine which alert message is associated with the choice included in the response message and thereby determine which actions, if any, to perform.

11. With regard to claim 2, Beyda further discloses that the action information comprises information compatible with a web-based application, wherein the web-based application is used to perform the action (alerts may be received from e-mail applications)(§37).

12. With regard to claim 3, Beyda further discloses that the sent message comprises a text-based message and the response message comprises a text-based message (both messages may be instant messages)(¶77).

13. With regard to claim 7, Beyda further discloses that sending the message to the device comprises sending the message to a mobile device (devices may be mobile)(¶28).

14. Claim 8 is rejected under the same rationale as claim 1, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

15. With regard to claims 11 and 12, Beyda further discloses that the sent message and the text message each comprise a plain-text message (both messages may be instant messages)(¶77).

16. Claim 15 is rejected under the same rationale as claim 1, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

17. With regard to claim 16 and 17, Beyda further discloses that the generated message comprises a text message and the response message comprises a text message (both messages may be instant messages)(¶77).

18. Claim 21 is rejected under the same rationale as claim 1, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

19. With regard to claim 22, Beyda further discloses that the one or more devices comprise mobile devices (devices may be mobile)(¶28).

20. With regard to claims 23 and 24, Kilduff further discloses that the mobile devices are configured to receive and send messages exclusive of web-based messages (SMS messages may be used by mobile telephones and PDAs)(¶43).

21. With regard to claim 25, Beyda further discloses that the application comprises a web-based application (application may be an e-mail applications)(¶37).

22. Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda (US 2003/0229670) in view of Kilduff (US 2003/0236763) further in view of Official Notice.

23. With regard to claims 4 and 14, while the system disclosed by Beyda and Kilduff shows substantial features of the claimed invention (discussed above), it fails to disclose sending a result of the performed action to the device.

The Examiner takes Official Notice that notifying a user of an execution result was old and well known in the art. In the context of electronic communications, it would be particularly advantageous to notify the user whether the action was properly completed because the response message could have been lost in transmission, and the user would not know. Furthermore, it would have been advantageous to notify the user whether the execution was successful to give the user an opportunity to take corrective action if the requested action was not successfully performed.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to notify the user of the execution result by sending a result of the performed action to the device.

24. Claims 5, 6, 13, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda (US 2003/0229670) in view of Kilduff (US 2003/0236763) further in view of Arneson et al. (US 2001/0056508).

25. With regard to claims 5 and 6, while the system disclosed by Beyda and Kilduff shows substantial features of the claimed invention (discussed above), it fails to disclose determining information indicative of the device, including information specific to the device and information specific to a user associated with the device, based on the

response message, and retrieving the stored information in response to the message identifier and the information indicative of the device.

Arneson discloses a similar system for notifying a user of event and allowing the user to reply to the notification with instructions to perform desired actions (§§10-11). Arneson teaches determining, from a response message, information specific to the device (identifier of calling device) and information specific to a user associated with the device (claim check) (§§53). This information is used to retrieve stored event information from a database (§§53; §60). This would have been an advantageous addition to the system disclosed by Beyda and Kilduff since it would have allowed the stored event information to be associated with both users and devices, allowing the system to share event messages among multiple users, yet still determine the actions desired by each respondent (Arneson; §§53).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use information specific to a device and information specific to the user of the device to retrieve stored information since it would have allowed the system to share event messages among multiple users, yet still determine the actions desired by each respondent.

26. Claims 13, 19 and 20 are rejected under the same rationale as claims 5 and 6, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

27. Claims 9, 10 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda (US 2003/0229670) in view of Kilduff (US 2003/0236763) further in view of Steinberg et al. (US 7,318,098).

28. With regard to claims 9, 10 and 18, while the system disclosed by Beyda and Kilduff shows substantial features of the claimed invention (discussed above), it fails to disclose that the information that enables one or more actions to be performed comprises web-based information, such as a URL, or that the performed actions are web-based actions.

Steinberg discloses a similar system for providing messages to mobile devices that allow users of the devices to perform certain actions (col. 2, ll. 1-35). Steinberg teaches storing web-based information, including URLs needed to communicate with web servers (col. 6, ll. 31-45) for performing web-based actions such as monitoring and bidding in on-line auctions (col. 6, ll. 46-65). This would have been an advantageous addition to the system disclosed by Beyda and Kilduff since it would have allowed users to interact with web based applications without requiring the users' devices to be web-enabled.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to store information, such as URLs, necessary for the users to interact with web-based applications with devices that are not web-enabled.

Conclusion

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON STRANGE whose telephone number is (571)272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aaron Strange/
Examiner, Art Unit 2453